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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,841	12/05/2003	Mohammed Samji	MSFT121180	8318

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BANNER & WITCOFF LTD.,
ATTORNEYS FOR CLIENT NOS. 003797 & 013797
1001 G STREET, N.W.
SUITE 1100
WASHINGTON, DC 20001-4597

EXAMINER

LY, ANH

ART UNIT PAPER NUMBER

2162

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/729,841

Applicant(s)

SAMJI ET AL.

Examiner

Anh Ly

Art Unit

2162

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-11, 19-40, 42-49, 51-56, 59-70, 72 and 73.
- Claim(s) withdrawn from consideration: _____.


AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____


JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2162


11/02/06

Continuation of 11. does NOT place the application in condition for allowance because:

Examiner maintains the rejection.

Applicants argued that, "the combination of Matsubara and Balfanz was improper." (page 12, 22-23).

In response to applicants' argument that there is no motivation or suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cl. 1992). In this case, Matsubara (Pub. No.: US 2003/0225796 A1) and Balfanz et al. (hereinafter Balfanz) are from the same field of endeavor and both are directed to P2P sharing files or collaboration system over a securely Internet network (Balfanz's sections 0022, 0027-0028; Matsubara's sections 0044 and 0082 fig. 4). One having ordinary skill in the art would have found it motivated to combine the teachings of Matsubara and Balfanz because that would provide Matsubara's system the enhanced capability of file sharing method by utilizing the use of a list of file sharing group having member on the sharable virtual directory over the network (Balfanz's sections 0024-0025), into the system of Matsubara for the purpose of enabling pre-authorized devices to access and share those files securely (Balfanz's section 0001). Moreover, the examiner kindly submits that the applicants misread the applicable references used in the last office action. However, when read and analyzed in light the specification, the invention as claimed does not support applicant's assertions. Actually, applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejections. Additionally, it is important to note that the examiner interpretation of the claims, wherein, the examiner explicitly stated passages in the cited references which were not even addressed. The aforementioned assertion wherein all the limitations are not taught or suggested by the prior of record, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. The examiner has provided in the last office action, a convincing one of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the cited references. Applicants are reminded that 37 CFR 1.111(b) states, a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Therefore, the applicants have failed to provided prima facie evidence how the language of the claims patentably distinguished them from the cited references. Hence, the applicants' assertions are just mere allegation with no supported fact.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argued that, "Matsubara does not teach or suggest "verfying that a file shar exists ...to be shared can be accessed remotely." and "wherein if a file share already exits, ... to allow the sharee to access the item that is to be shared."" (page 12, last 3 lines and page 13, lines 1-3).

Matsubara teaches P2P file sharing system such as GnuTella, Napster, and Kazaa, enables users to share files and other digital objects from devices under their control, that is, a file of a user (sharer) files on the system are available to be shared with other users (sharee) on the system. And the file is to be checked, confirmed and ensured that it was registered (existing on the system) as well as its content (sections 0008, 0037-0038 and 0039, also see abstract and fig. 3 and sections 0063-0079).

Applicant argued that, "Matsubara does not teach or suggest "verifying that the sharer's firewall ...to access the shared virtual folder item."" (page 13, lines 14-16).

Matsubara teaches P2P file sharing system is on a security Internet network having a software or firewall as a gateway to protect from accessing the files, from which the distribution files can be encrypted to provide security, thus allowing the sharee to access the shared virtual item or files in a security manner with a security protocol (sections 0037, 0040-0047) (also see Balfanz's sections 0019 and 0034).

Applicant argued that, "Matsubara does not teach or suggest "sending a link to the sharee ... and at least one sharee." (page 14, lines 1-2).

Matsubara teaches the file sharing system cooperate with the server system to facilitate manipulations to the virtual directory, which is containing a plurality of referenced items, access control list containing an ordered list of rules and providing to limit access to a file and access control such as read, write, modify delete...can be based on the individuals or groups and access control defining the individuals or groups of individual being had access capability to access the file, sharing the file over the Internet network for peer-to-peer file sharing based on the ACL and access rights to the shared files, and file links (figs. 1, 6 & 9, section 0063; also section 0027). Also, Balfanz teaches the P2P fileshares can communication and share file information with each other (section 0022).